

Appl. No. 10/824,118  
Docket No. 9209M  
Amdt. dated March 27, 2008  
Reply to Office Action mailed on December 27, 2007  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1-24 are pending in the present application. Claims 18-21 were previously withdrawn. Claims 7 and 17 are canceled and incorporated into amended Claim 1. Claims 8 and 13 are currently amended to correct dependency. No additional claims fee is believed to be due.

### Rejection Under 35 USC §102(b) Over Drechsler

Claims 1-16 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Drechsler *et al.*, U.S. Pat. No. 6,139,823 (hereinafter “Drechsler”). However, Drechsler does not teach or suggest a combination of diorganopolysiloxane polymer and aminosilicones in an anhydrous mixture as newly amended Claim 1 recites.

Further, to insure this 102(b) rejection is overturned, Applicants currently amend Claim 1 to incorporate Claim 17, which was not rejected under §102(b) as allegedly being anticipated by Drechsler. Applicants contend that Drechsler does not anticipate Applicants’ amended Claim 1 because it does not disclose each and every aspect of the features recited in independent Claim 1. As noted on page 8 of the Office Action, Drechsler “does not explicitly teach the use of a kit nor does it teach that the topcoat composition is selected from aminosilicones, carboxy modified silicones, epoxy modified silicones and mixtures thereof.”

Accordingly, Applicants maintain that Claims 2-16 are not anticipated because they depend from Claim 1. Therefore, Applicants assert that the present invention is novel in view of Drechsler and the §102(b) rejection should be withdrawn.

### Rejection Under 35 USC §103(a) Over Drechsler in view of Nichols

Claims 17-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler *et al.*, U.S. Pat. No. 6,139,823 (hereinafter “Drechsler”) in view of Nichols, U.S. Pat. No. 6,010,709 (hereinafter “Nichols”). Of the rejected claims, Claims 18-21 are withdrawn, while Claim 17 is currently canceled and incorporated into Claim 1. Accordingly, Applicants respectfully disagree as to Claims 1 and 22-24.

The Office has not demonstrated all aspects of a *prima facie* case of obviousness; accordingly, the Office's opinion of obviousness is deficient and Applicants request allowance of the pending claims. The four factual inquiries that are used to determine obviousness under 35 U.S.C. §103(a) are: 1. determining the scope and contents of the prior art, 2. ascertaining the differences between the prior art and the claims at issue, 3. resolving the level of ordinary skill in the pertinent art, and 4. considering objective evidence present in the application indicating obviousness or nonobviousness.<sup>1</sup>

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modification.<sup>2</sup>

The Federal Circuit clarified that when an examiner uses two or more references to establish an obviousness rejection, it is essential to "ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification."<sup>3</sup> Accordingly, the examiner must demonstrate why it "would appear" that references concerning assorted features of the invention would have been combined.<sup>4</sup>

The "suggestion or motivation" to combine references criterion was addressed by the Supreme Court in its recent *KSR Int'l Co. v. Teleflex* decision.<sup>5</sup> The Court stated that it is necessary to "determine whether there *was* an apparent reason to combine the known elements *in the fashion claimed* by the patent at issue. To facilitate review, this analysis should be made *explicit*."<sup>6</sup> Thus, the Patent Office must make it clear in the record that the teaching-suggestion-motivation to modify the reference exists. As stressed by the Court, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>7</sup>

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<sup>1</sup> *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

<sup>2</sup> *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972).

<sup>3</sup> *In re Lahu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

<sup>4</sup> *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

<sup>5</sup> *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

<sup>6</sup> *Id.*, slip op. at 14 (emphasis added).

<sup>7</sup> *KSR*, 127 S. Ct. 1727.

Chapter 2100, *inter alia*, of the Manual of Patent Examining Procedure (“MPEP”) was revised to incorporate examination guidelines for determining obviousness under §103 in light of the Supreme Court’s 2007 *KSR* decision.<sup>8</sup> According to the guidelines, a rejection under §103 should be supported by clearly articulated reasons why the claimed invention would have been obvious.<sup>9</sup> Exemplary rationale (G) that may support a conclusion of obviousness is “[s]ome teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.”<sup>10</sup> Likewise, the Board of Patent Appeals and Interferences recently emphasized that examiners must still give strong reasons for their rejections.<sup>11</sup>

The *KSR* decision also was the subject of a May 3, 2007 memorandum from the Deputy Commissioner for Patent Operations to technology center directors, which stated that the four factual inquiries of *Graham* were reaffirmed by the Court and that although the Court rejected a rigid application of the “teaching, suggestion, or motivation” test, the Court *did not* totally reject the “teaching, suggestion, or motivation” test.<sup>12</sup> In discussing the *KSR* decision,

(4) [t]he Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed.<sup>13</sup>

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<sup>8</sup> MPEP § 2100; *KSR*, 127 S. Ct. 1727.

<sup>9</sup> See MPEP 2143.

<sup>10</sup> *Id.*

<sup>11</sup> See Board of Patent Appeals and Interferences decision on May 10, 2007 re: U.S. App. 09/757,913: “After carefully considering both the Chen and Maggenti references, we find no specific teaching or suggestion within either reference that fairly meets the language of the claim that requires ‘stopping the context information updating. . .,’ and ‘taking a snapshot of the compression and decompression context information . . .’ (claim 1). We find that to affirm the Examiner on this record would require speculation on our part... Because we find the combination of Chen and Maggenti fails to teach or suggest all the limitations recited in the claim, we agree with Appellants that the Examiner has failed to meet the burden of presenting a *prima facie* case of obviousness. Accordingly, we will reverse the Examiner’s rejection of independent claim 1 as being unpatentable over Chen in view of Maggenti.”

<sup>12</sup> Focarino, Margaret, Deputy Commissioner for Patent Operations, USPTO “Supreme Court decision on *KSR Int’l. Co., v. Teleflex, Inc.*,” internal memo to USPTO technology art unit directors, May 3, 2007.

<sup>13</sup> *Id.*, p. 2.

Furthermore, 35 U.S.C. § 103(a) requires the “subject matter as a whole” to have been obvious in order to sustain an obviousness rejection:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicants' disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.<sup>14</sup>

Applicants respectfully traverse this obviousness rejection for two reasons. First, there was no motivation to combine Drechsler and Nichol. Second, even if the references were combined, Applicants’ “subject matter as a whole” is not rendered obvious because the combination does not teach or suggest all of the claim limitations of independent Claims 1 and 22-24. The differences between the claimed subject matter and the Drechsler-Nichols combination are not such that the claimed subject matter “would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”<sup>15</sup>

A person skilled in the art, after reading the Drechsler and Nichols references, would not have considered combining the “transfer-resistant cosmetic composition” of Drechsler with the “smear-resistant cosmetic” of Nichols. They are both base coat compositions. It is not prima facie obvious to combine the compositions of Drechsler and Nichols to yield the basecoat/topcoat composition of Claim 1. The two compositions are

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<sup>14</sup> MPEP § 2142; *See also Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1595-96 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). “Inventions typically are new combinations of existing principles or features....The ‘as a whole’ instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole.”

<sup>15</sup> *See* 35 U.S.C. §103(a).

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both useful for the same purpose— basecoats; however, they do not form a third composition to be used for the very same purpose. If they did, the Drechsler-Nichols combination would form another basecoat, not a topcoat as disclosed in the present invention. Accordingly, a rejection of the claims over a combination of Drechsler and Nichols should be withdrawn.

Further, even if there were a motivation to combine Drechsler and Nichols, the combination of the two would not render obvious the subject matter of Applicants' invention as a whole. Importantly, the components of the invention were not already known in the art. Drechsler and Nichols in combination do not teach or suggest all of the claim limitations of independent Claims 1 and 22-24. Applying MPEP 2143.03, all of the claim limitations must be considered when weighing the differences between the claimed invention and the prior art in determining obviousness.

As the Office noted on page 8 of the Office Action, Drechsler “does not explicitly teach the use of a kit.” Nor does Nichols explicitly teach or suggest the use of a basecoat and topcoat kit. Rather, Nichols teaches the use of a kit comprising a cosmetic and a cosmetic remover. Accordingly, the combined disclosures of Drechsler and Nichols do not teach or suggest a lip cosmetic kit comprising a topcoat composition.

As the Office noted on page 8 of the Office Action, Drechsler “does not explicitly ... teach that the topcoat composition is selected from aminosilicones, carboxy modified silicones, epoxy modified silicones and mixtures thereof.” The Office alleged on page 9 that “[t]he components are known in DRECHSLER, however, not specifically as a topcoat.” But, aminosilicones, carboxy modified silicones, epoxy modified silicones were not even mentioned as such in Drechsler. In fact, the only mention of “amino” is in claims 6 and 14. And even then, the amino disclosed is a fluid diorganosiloxane resin comprising repeating units of the formula  $R_2SiO$  where R is an amino alkyl hydrocarbon side group. The aminosilicone of the present invention is different from the diorganopolysiloxane polymer of Drechsler, which is also recited by Applicants.

Further, the components are not known as a topcoat in Nichols either. Nichols offers no teaching, suggestion, or motivation to use modified silicone components selected from aminosilicones, carboxy modified silicones, epoxy modified silicones in a topcoat composition. A person having ordinary skill in the art would not have known to

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use aminosilicones, for example, as a topcoat with the claimed basecoat because even if its properties and purpose for inclusion in a lip composition would be the same, it would not interact with all basecoats in the same manner.

In view of the foregoing, Applicants respectfully submit that Claims 1 and 22-24, and the claims depending therefrom, are patentably distinct from the combined disclosures of Drechsler and Nichols. Reconsideration and withdrawal of the Section 103 rejection of record is requested.

#### Conclusion

Applicants have made an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, Applicants respectfully request entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims.

Respectfully submitted,

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